

**Nominet UK Dispute Resolution Service**

DRS 03806

**(1) The Royal Bank of Scotland Group plc (2) National Westminster Bank plc (3)  
Direct Line Insurance plc (4) Privilege Insurance Company Limited**

–v–

**Laurent Girault**

Decision of Independent Expert

**1. Parties:**

Complainants: (1) The Royal Bank of Scotland Group plc (2) National  
Westminster Bank plc (3) Direct Line Insurance plc (4)  
Privilege Insurance Company Limited

Address: Business House F  
Gogarburn  
Post Office Box 1000  
Edinburgh  
Postcode: EH12 1HQ  
Country: GB

Respondent: Mr. Laurent Girault

Address: 17 Burmester Road  
London  
Postcode: SW17 0JN  
Country: GB

**2. Domain Names:** natwestcards.co.uk; privilege.co.uk (“the Domain Names”).

**3. Procedural Background:**

The Complaint was lodged with Nominet on 30 June 2006. Nominet validated the Complaint and notified the Respondent of the Complaint on 4 July 2006 and informed the Respondent that he had 15 days within which to lodge a Response. The Respondent failed to respond. Mediation not being possible in those circumstances, Nominet so informed the Complainants and on 28 July 2006 the lead Complainant paid Nominet the appropriate fee for a decision of an Expert pursuant to paragraph 7 of the Nominet UK Dispute Resolution

Service Policy (“the Policy”) and paragraphs 5(d) and 8 of the Nominet UK Dispute Resolution Service Procedure (“the Procedure”).

Andrew Murray, the undersigned, (“the Expert”) has confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as Expert in this case and further confirmed that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality. On 8 August 2006, Nominet invited the undersigned, the Expert, to provide a decision on this case.

#### **4. Outstanding Formal/Procedural Issues (if any):**

The Respondent has not submitted a Response to Nominet in time (or at all) in compliance with paragraph 5(a) of the Procedure.

The Expert has seen copy communications from Nominet to the Respondent and has no reason to doubt that the Respondent has been properly notified of the Complaint in accordance with paragraphs 2 and 4(a) of the Procedure. Paragraph 15(b) of the Procedure provides, *inter alia*, that: “If in the absence of exceptional circumstances, a Party does not comply with any time period laid down in this Policy or the Procedure, the Expert will proceed to a Decision on the complaint.” There is no evidence before the Expert to indicate the presence of exceptional circumstances; accordingly, the Expert will now proceed to a Decision on the Complaint and notwithstanding the absence of a Response.

The lack of a Response does not entitle the Complainants to a default judgement. The Complainants must still prove their case to the required degree. The Expert will evaluate the Complainants’ evidence on its own merits and will draw reasonable inferences from it in accordance with paragraph 12(b) of the Procedure. Paragraph 15(c) of the Procedure provides that: “If, in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or this Procedure ..... , the Expert will draw such inferences from the Party’s non-compliance as he or she considers appropriate.”

Generally, the absence of a Response from the Respondent does not, in the Expert’s view, entitle an Expert to accept as fact all uncontradicted assertions of the Complainants, irrespective of their merit. In this case it seems to the Expert that the probable facts speak for themselves and that it is not necessary to draw any special inferences. The Expert finds that the probable facts asserted by the Complainants and set out in the following section are indeed facts.

#### **5. The Facts**

5.1 The lead Complainant, The Royal Bank of Scotland Group plc (RBS), is a leading provider of financial services and one of the oldest banks in the UK. RBS has offices in Europe, the United States and Asia. RBS offers a range of financial products and services – including retail banking, wealth management and insurance services – to both individual and institutional investors throughout the world. RBS has been registered at Companies House since 1968.

- 5.2 A significant part of RBS's business today revolves around its retail banking business. RBS provides retail banking services through numerous brands, including second Complainant National Westminster Bank plc (NatWest). NatWest was formed as the result of a merger in 1968 and adopted the "NatWest" title in the 1990s. NatWest is part of the fifth-largest financial services group in the world, with more than 1,600 branches and offers a wide range of financial products and services, including credit card services, to individual and institutional investors. NatWest is registered at Companies House and has been so registered since 1968.
- 5.3 Another significant part of RBS's business is its insurance services business. RBS provides insurance services through RBS Insurance Services Ltd., which owns numerous brands aimed at its customers' varying insurance needs, including third Complainant Direct Line Insurance plc (Direct Line) and fourth Complainant Privilege Insurance Company Limited (Privilege). Direct Line was formed on 2 April 1985 and offers a broad range of products and services, including car and home insurance services, to over five million customers across the UK and in Europe. Direct Line is registered at Companies House and has been so registered since 1984. Privilege specialises in offering car insurance, with home and breakdown coverage also available. Privilege is registered at Companies House and has been so registered since 1993.
- 5.4 The Complainants provide evidence that:
- (a) Second Complainant NatWest possesses a number of proprietary interests in the name "NatWest" including several Community trade marks, a portfolio of UK trade marks and an international portfolio totaling over one hundred trade mark registrations in the name "NatWest" alone.
  - (b) Third Complainant Direct Line possesses a number of proprietary interests in the name "Privilege" including UK trade marks for "Privilege", "Privilege Insurance" and "Privilege Home Insurance".
- 5.5 The Domain Name natwestcards.co.uk was registered on 16 May 2005 by the Respondent. The Domain Name is currently used to display a website containing links to financial services institutions including Citibank, Smile (owned by competitor the Co-operative Bank) and several financial intermediaries such as EasyMoney.com and Loan-Saver.net.
- 5.6 The Domain Name privalege.co.uk was registered on 11 August 2004 by the Respondent. (Although it should be noted that the Whois records the Registrant's name as "Girault Laurent", the Expert is satisfied that the Respondent simply listed his last name first in connection with this registration.) The Domain Name is currently used to display a website containing links to insurance brokerages specialising in car insurance, including direct competitor More Than Insurance.

## 6. The Parties' Contentions

Complainants:

The Complainants contend that:

The Complainants have rights in the Domain Names because:

- 6.1 Second Complainant NatWest has numerous registrations for "NatWest" and related marks, including with the UK Patent Office and with the EU Office for Harmonisation in the Internal Market.
- 6.2 NatWest and its affiliates own domain name registrations featuring the well-known NatWest mark, including natwest.co.uk (registered prior to August 1996) and natwest.com. NatWest uses these domain names to promote and operate its financial services business.
- 6.3 Third Complainant Direct Line holds registrations for Complainants' Privilege and related marks, including with the UK Patent Office and has an application currently pending in the Office for Harmonisation in the Internal Market to register the Privilege mark.
- 6.4 The Complainants and their affiliates own numerous domain names featuring their well-known Privilege mark, including privilege.co.uk (registered prior to August 1996), privilege.com, privilege.net, and privilege.biz. Complainant Privilege uses these domain names to promote and operate its insurance business.
- 6.5 The Domain Names are similar to the Complainants' names and marks.
- 6.6 In relation to the Domain Name "natwestcards.co.uk". This is similar to the Complainants' NatWest name and mark. The Respondent has simply added to Complainants' mark the word "cards" – which corresponds to a service the Complainants offer. The NatWest mark remains the dominant and distinctive element in the Domain Name, and the Domain Name's confusing similarity to Complainants' mark conveys the impression that the Domain Name is sponsored by, or somehow associated with, the second Complainant and that it relates to NatWest's financial services business.
- 6.7 But for the word addition noted, the Domain Name is identical to the Complainants' "natwest.co.uk" domain name.
- 6.8 In relation to the Domain Name "privalege.co.uk". This is almost identical to the Complainants' Privilege name and mark. The Respondent has simply substituted the letter "a" for the second "i" in the mark. The Complainants' Privilege mark remains the dominant and distinctive element in the Domain Name, and the Domain Name strongly conveys the impression that it is sponsored by, or associated with, the fourth Complainant and its business and services.

- 6.9 But for this letter substitution, the Domain Name is identical to Complainants' "privilege.co.uk" domain name.
- 6.10 The Domain Names are apparently targeted toward internet users who, while seeking to access Complainants' websites and financial services, either make slight errors when typing in Complainants' actual domain names or attempt to access Complainants' services by typing in Complainants' names along with a service Complainants provide. Such users find themselves at Respondent's websites, which contain advertising for, and links to websites offering, competing products and services.
- 6.11 The Respondent registered "natwestcards.co.uk" on 16 May 2005 and registered "privalege.co.uk" on 11 August 2004 – long after Complainants acquired rights to their names and marks.
- 6.12 The Respondent has no apparent rights to either of the Domain Names.

The Domain Names in the hands of the Respondent are abusive as:

- 6.14 The Respondent has registered the Domain Names for the purpose of unfairly disrupting the Complainants' business in contravention of Paragraph 3(a)(i)(C) of the Policy. The Domain Names are targeted toward internet users seeking access to Complainants' products and services. Such users are taken to Respondent's websites which promote financial products and services offered by Complainants' competitors. Such use of the Domain Names threatens to disrupt Complainants' business by, for instance, improperly directing Complainants' current and prospective customers to Complainants' competitors, thus causing Complainants to suffer loss of business and revenue. Such use constitutes evidence of an abusive registration under Paragraph 3(a)(i)(C) of the Policy.
- 6.15 The Respondent is using the Domain Names in a way that has confused people into believing, and has the potential to confuse people into believing, that the Domain Names are registered to the Complainants, are operated or authorised by Complainants, or otherwise are connected with Complainants in contravention of Paragraph 3(a)(ii) of the Policy. Given the similarity of the Domain Names to the Complainants' marks, and domain names, an internet user intending to access Complainants' websites could find himself at Respondent's websites without realising that he had failed to reach the Complainants' sites. Further, the content of Respondent's websites, because it consists of information and advertising concerning products and services similar to those offered by Complainants, would not necessarily alert the user to his or her error. Additionally, even if a user realised that he was not at Complainants' official website, the user still could be confused into believing that Complainants were in some way associated with the Domain Names, given these substantial similarities.

6.16 The Domain Names are abusive registrations because the Respondent is using them to benefit commercially from his unauthorised and illegitimate use of Complainants' marks and associated goodwill and thus is using the Domain Names in a manner that takes unfair advantage of and is unfairly detrimental to Complainants' rights in contravention of the Policy (See Policy, Paragraph 1 (defining Abusive Registration.)). Specifically, the Respondent's purpose in redirecting internet users searching for Complainants' products and services, including the Complainants' current and prospective customers, to the websites of Complainants' competitors is presumably to generate click-through revenues based on the amount of traffic he diverts to those sites. The Respondent's attempt to profit financially from his unauthorised use of Complainants' marks is commercially exploitive of Complainants' names and marks and evidences an abusive registration under the DRS Policy.

Respondent:

6.17 The Respondent has not responded.

## **7. Discussion and Findings**

### **7.1 General**

According to paragraph 2 of the Policy, in order to succeed in this complaint, the Complainant has to prove to the Expert that, on the balance of probabilities that:

- i. the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; **and**
- ii. the Domain Name, in the hands of the Respondent, is an Abusive Registration.

These matters must be proven by the Complainant, notwithstanding the failure by the Respondent to respond. The effect of the Respondent's default is rather that, under paragraph 15(c) of the Procedure (there being no exceptional circumstances in this case) the Expert is required to draw such inferences from the Respondent's non-compliance as he considers appropriate.

### **7.2 Complainant's Rights**

Rights are defined in the Policy as including, but not limited to, rights enforceable under English law. This is usually demonstrated by reference to a trade mark registration or evidence of active trading using the name or mark in question.

In this case, the Complainants rely upon their registered rights in the marks "NatWest" and "Privilege" and in their domain names "natwest.co.uk" and "privilege.co.uk". The second Complainant has demonstrated that they hold a series of trade mark registrations at the UK Trade Marks Registry, at EU Office for Harmonisation, as well as many other trade mark registries around the globe in the term "NatWest", while the fourth Complainant has similarly demonstrated UK and Irish registrations in the term

“Privilege”, and a current application before the EU Office for Harmonisation. Both have further clearly traded under these trading names for some years prior to these registrations having been taken out.

Is the Domain Name “natwestcards.co.uk” sufficiently similar to the Complainants’ NatWest name and mark? As noted by the Complainants in their Complaint: “The Respondent has simply added to Complainants’ mark the word ‘cards’ – which corresponds to a service the Complainants offer. The NatWest mark remains the dominant and distinctive element in the Domain Name, and the Domain Name’s confusing similarity to Complainants’ mark conveys the impression that the Domain Name is sponsored by, or somehow associated with, second Complainant and that it relates to NatWest’s financial services business.” The Complainants also direct the Expert to take account of the decision in National Westminster Bank Plc. v 2catchafly DRS 03390 where the Expert, Mr. James Bridgeman, found:

It is clear that the domain name in issue <natwestloans.co.uk> is similar to the Complainant’s mark, consisting of the identical word “natwest” together with the generic descriptive term “loans”. The word “natwest” is the dominant element in the domain name and the similarity of the domain name to the Complainant’s mark is compounded by the fact that the additional generic element, the word “loans”, is descriptive of an important part in the Complainant’s business and the provision of loans is a field of activity in which the Complainant has an established goodwill in the UK market.

I find myself in complete agreement with Mr. Bridgeman’s analysis in this decision and find that the Complainants have established rights in respect of a name similar to the Domain Name “natwestcards.co.uk”.

In relation to the Domain Name “privalege.co.uk”. The Complainants note: “this is almost identical to the Complainants’ Privilege name and mark.”. This is clearly a case of alleged typosquatting. Typosquatting cases have been considered several times in the DRS, including The Carphone Warehouse Limited v Russell Wilkes DRS 02086, Yahoo! Inc v Simon Charles Smith DRS 00821 and Re: Morganstaniey.co.uk DRS 02959. In each case of this type the Expert has been happy to accept that a misspelling of a name or mark qualifies it as sufficiently similar for paragraph 2 of the Policy. In the instant case I am happy to follow this line of reasoning and so find that the Domain Name “privalege.co.uk” is similar to the Complainants’ Privilege name and mark.

Therefore on the basis of the evidence presented the Expert is satisfied that the Complainants have rights in respect of the marks “NatWest” and “Privilege” which are sufficiently similar to the Domain Names in question. Consequently, the Expert finds that, for purposes of the Policy, the Complainants have rights in respect of a name or mark, which is identical or similar to the Domain Names.

### **7.3 Abusive Registration**

Paragraph 1 of the Policy defines “Abusive Registration” as:-

“a Domain Name which either:

- i. was registered or otherwise acquired in a manner, which at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant’s Rights; OR
- ii. has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.”

Under paragraph 3(a) of the Policy is listed a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. The Complainants have indicated that they believe that in particular they may make out a claim under paragraph 3(a)(i)(C):

“The Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant.”

And further under paragraph 3(a)(ii):

“Circumstances indicating that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant”

### **7.3.1 Paragraph 3(a)(i)(C)**

In making their claim under paragraph 3(a)(i)(C), the Complainants further refer the Expert to the decision in National Westminster Bank Plc. v 2catchafly DRS 03390 where the Expert found that: “By knowingly linking the domain name <natwestloans.co.uk> to a site that offers links to other sites offering financial services, and particularly loans, by competitors of the Complainant, on the balance of probabilities, reason would infer that the primary purpose of registration of that domain name was to unfairly take advantage of the Complainant’s reputation and to divert Internet users to the Respondent’s website and thereby unfairly disrupt the business of the Complainant.” In addition the Complainants refer the Expert to the Expert decision in Yahoo! Inc v Simon Charles Smith DRS 00821 where the Expert noted that: “it seems that by registering the Domain Name, the Respondent could have no purpose other than to intend that the Domain Name be confused with the Yahoo! mark, thereby intending primarily to divert business from the Complainant...This is therefore likely to unfairly disrupt the business of the Complainant.”

Having taken these decisions into consideration, along with the similar decisions in The Carphone Warehouse Limited v Russell Wilkes DRS 02086 and Re: Morganstaniey.co.uk DRS 02959, it seems to be that the only reason the Respondent had registered, and is

using, the Domain Names is, in the Complainants' words, "to generate click-through revenues based on the amount of traffic he diverts to those sites." There seems to be no reason for the Respondent to use the Domain Names except to profit at the Complainants' expense, and there seems to be a high risk of confusion on the part of internet users. Both these findings suggest a *prima facie* finding that on the balance of probabilities "The Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainants".

### **7.3.2 Response**

Having found the Complainants to have made out a *prima facie* case under the Policy the burden under paragraph 4 now shifts to the Respondent to demonstrate their use is not an Abusive Registration. The Expert having found the Respondent has a case to answer, the Respondent must make that answer. Here the Respondent has failed to answer and therefore cannot rebut the presumption of Abusive Registration.

### **7.3.3 Finding**

Accordingly, the Expert finds that the Domain Names are an Abusive Registration as defined by paragraph 1 of the Policy on the basis that they are being used in a manner which takes unfair advantage of the Complainants' rights.

## **8. Decision:**

In light of the foregoing findings, namely that the Complainants have rights in respect of names which are similar to the Domain Names and that the Domain Names, in the hands of the Respondent, are Abusive Registrations, the Expert directs that the Domain Names, natwestcards.co.uk and privalege.co.uk, be transferred to the lead Complainant.

Andrew Murray

Date: 10 August 2006